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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,598

09/10/2003

Miri Seiberg

JBP-430-CIP1

5368

27777 7590 11/24/2009  
PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

GEMBEH, SHIRLEY V

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,598	<b>Applicant(s)</b> SEIBERG ET AL.	
	<b>Examiner</b> SHIRLEY V. GEMBEH	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/10/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 73-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Response to Arguments**

1. The response filed on **8/10/09** has been entered.
2. Applicant's argument filed on 9/12/08 has been fully considered but they are not deemed to be persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 73-86 are pending in this office action.
5. The rejection of claims 73-86 under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 5,534,265) in view of Meybeck et al. (US 5,034,228) and Sessa et al. (1986) and Seiberg et al. (1997) and Avramiotis et al (1996) is withdrawn because Fowler fails to teach that synthetic soy flour hectorite co has trypsin-inhibiting activity.

### ***Priority***

6. Applicant claims that application 09/110,409 contains the subject matter "non-denatured soybean extract". This is found not persuasive. Page 16, line 1-3 alternatively disclose natural extracts which is not the same as "non-denatured soybean

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extract". The support for 09/698,454 is found persuasive. Thus, priority is granted to only the filing date, 9/10/03.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 73-86 under 35 U.S.C. 103(a) as being unpatentable over Jin (CN166960A published 12/10/1997) in view of Meybeck et al. (US 5,034,228).

Jin teaches a composition comprising soybean protein powder for treating the face, wherein after several application of the mask, the acne is obviously decreased (see translated abstract, as required by instant claims 73, 75, 77, 78). Because Jin does not heat, etc. his soybean powder, it is therefore considered non-denatured (as required by instant claim 73). Inherently, the soy flour/powder will have trypsin-inhibiting activity because "products of identical chemical composition can not have mutually exclusive properties (see MPEP 2112.01).

Because Jin teaches that the powders of these natural products are mixed, it is reasonable to conclude that the mixing involves the use of water, and therefore the powder will form a paste when in contact with a liquid or a solvent. Thus it is reasonable to conclude that Jin teaches soybean paste as well (as required by instant claim 74).

However Jin fails to teach the composition for reducing/treating acne further comprises tretinoin.

Meybeck et al. teach treating acne with soya lecithin and tretinoin (as required by instant claims 73-74 and 76-78 are met. See col. 3, lines 36-38 and lines 61-64) wherein the application is topical (as required by instant claim 83, see col. 3, lines 35-37. With regard to claim 75, the Meybeck teaches tretinoin as vitamin A, (see col. 2, line 42). Meybeck et al. also teaches the formulation may comprise 2 g of soy lecithin and

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0.1 g of tretinoin which is within the recited limitations of 0.01 to about 0.3% tretinoin and 0.01-50% of soybean in claims 79, 81-83 and 85-86 (see col. 3, line 62).

One of ordinary skill in the art would have been motivated to expand the treatment composition taught by Jin to incorporate Meybeck's treatment method by substituting the soy lecithin (soybean extract) in Meybeck with the soybean powder/flour of Jin because Jin teaches that when soybean flour is applied to the face, it diminishes acne considerably. One of ordinary skill in the art would routinely add water to the soy flour and form a paste. Therefore the use of soy flour is equivalent to using soy paste as required by instant claim 74. Since tretinoin is known in the art to be interchangeable with retinoid or vitamin A, one of ordinary skill in the art would have employed either tretinoin or vitamin A in a composition for treating acne since vitamin A is well known in the art for treating acne.

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL HARTLEY can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S.V.G./  
Examiner, Art Unit 1618  
5/15/09

/Robert C. Hayes/  
Primary Examiner, Art Unit 1649